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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/135,034 08/17/98 MCMILLAN

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EXAMINER

COSIMANO, E

ART UNIT

PAPER NUMBER

2761

DATE MAILED: 08/13/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/135,034

Applicant(s)
McMillan et al

Examiner
EDWARD COSIMANO

Group Art Unit
2761



☒ Responsive to communication(s) filed on Jul 1, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 21-24, 26, 28-34, 37 & 38 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 21-24, 26, 28-34, 37 & 38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.

2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, & § 1.84(o,p(5)).

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

3.1 A timely filed terminal disclaimer in compliance with 37 CFR 1.321[®] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

3.1.1 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.2 Claims 21-24, 26, 28-34, 37 & 38 are rejected under the judicially created doctrine of double patenting over claims 1-26 of U. S. Patent No. 5,797,134 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

3.2.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: subject matter of claims 21-24, 26, 28-34, 37 & 38 of the instant application are also claimed in at least claims 1, 12, 16 & 22 of U. S. Patent No. 5,797,134.

3.2.2 Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

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See also MPEP § 804.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.1 Claims 21-24, 26, 28-34, 37 & 38 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Camhi et al (5,430,432) or Ousbourbe (5,499,182).

4.1.1 In regard to claims 21-24, 26, 28-34, 37 & 38, either Camhi et al ('432) or Ousbourbe ('182) disclose a system which collect operational data about a vehicle. The data is then analyzed to determine if a trigger event of some type has occurred. When a trigger event has occurred, then the monitored operational data is stored in a different storage unit for further analysis. This analysis clearly as taught by:

A) Camhi et al ('432) at column 1, lines 31-37, ("This information ..., and used by insurance companies for liability and premium determinations."); and

B) Ousbourbe ('182) at columns 1-2, ("The subject driver ... drivers they already insure.");

is to analysis data of interest to insurance company for the purpose of determining the cost of insurance based on driver habits. Hence, these systems are to record data which is to be used by an insurance company for the purpose of determining the cost of insurance based on driver habits.

5. Response to applicant's arguments. - - -

5.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

5.2 As per the 35 U.S.C. § 102 rejection, since:

A) the instant claims do not contain the same limitations and hence are actually broader in scope than the claims in U. S. Patent No. 5,797,134, the reasons for allowance set forth in U. S. Patent No. 5,797,134 can not be applied to the instant claims. Therefore, applicant's argument's are non persuasive.

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6. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703)-305-9714. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

7.1 The fax phone number for UNOFFICIAL FAXES for this group is (703) 305-0040.

7.2 The fax phone number for OFFICIAL FAXES for this group is either (703) 308-9051 or (703) 308-9052.

08/11/99



Edward R. Cosimano
Primary Examiner A.U. 2761